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Remarks

Claims 1-13 have been canceled. Claims 14-21 have been added. Claims 14-21 are pending. Applicant respectfully acknowledges that claim 11 contains allowable subject matter. Support for new claims 14-21 appear in general throughout the Specification and in particular as follows:

<u>Claim</u>	<u>Support</u>
14	Original claims 1 and 3, page 4, line 22 page 5, line 10, page 8, lines 2-10, and Figs 4 and 5
15	Original claim 2
16	Original claim 4
17	Original claim 5
18	Page 4, lines 22-25
19	Page 4, lines 22-25
20	Page 4, lines 12-14
21	Original claims 1 and 3, page 4, line 22 page 5, line 10, page 8, lines 2-10, Figs 4 and 5, and page 4, lines 22-25

§ 112 Rejections

Claims 8-13 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, claims 8-13 depended on cancelled claim 1, and in claim 8, the term "container" lacked antecedent basis. New claims 14-21 have been drafted to address each of these matters.

§ 103 Rejections

Claims 7-10, and 13 stand rejected under 35 USC § 103(a) as being unpatentable over Close (U.S. 4,265,953) in view of Chang (U.S. 5,961,766). New independent claim 14 is believed to be patentable over the cited references for the reasons set forth below.

New independent claim 14 is directed to a firestop device comprising intumescent material, a container surrounding the intumescent material, adhesive arranged on the container, and a liner including a first portion covering the adhesive, a second portion arranged in at least partially overlapping relation with the liner first portion, and a tab portion arranged adjacent the

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liner second portion. In this manner, the tab can be pulled to release the liner first portion from the adhesive to expose at least a portion of the adhesive to adhesively bond the device at a desired location. None of the cited references, whether taken alone or in combination, disclose, teach or suggest, express or implied, such a firestop device.

The Close reference discloses a composite or tape comprising a thin, flexible, compliant, strong, stressable substrate, a layer of flexible, resilient intumescent material adhered to the substrate and adhesive means for closing the substrate on itself. Close, however, fails to disclose a container surrounding the intumescent material, or a liner including a second portion arranged in at least partially overlapping relation with a first portion of the liner and a tab portion arranged adjacent the second portion of the liner as defined in new claim 14. The Chang et al. reference does not cure the deficiencies of Close.

Chang et al. reference relates to a method for selecting a substrate intended for use in a cutting operation. The method is particularly suitable for selecting facestock material intended for use in making pressure-sensitive adhesive (PSA) constructions such as PSA labels. Because Chang et al. is from a different field of endeavor (i.e. making PSA labels, not intumescent firestop devices) and because the art is not reasonably pertinent to the particular problem involved with the present invention (i.e. preventing the spread of fire and smoke in a building), Chang et al. is nonanalogous art and cannot be considered as prior art.

Moreover, even if Chang et al. were prior art, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. In the present case, there is no suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. And because it is not clear how one would combine the references, the reasonable expectation of success is also lacking. Finally, even if the reference teachings were combined, the references would not meet the claim because neither reference discloses a container around the intumescent material. Accordingly, new independent claims 14 and 21 are believed to be patentable over the cited reference.

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The remaining dependent claims, as depending from allowable claims, are also deemed to be in condition for allowance. In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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Date

By: David B Patchett
David B. Patchett, Reg. No.: 39,326
Telephone No.: (651) 736-4713

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833